

REMARKS

Claims 1, 12, and 22 are amended, no additional claims are canceled with this response, and claims 25-26 are added; as a result, claims 1-13 and 17-26 are now pending in this application.

No new subject matter has been added through the amendments to claims 1, 12, and 22. Support for the amendments to claims 1, 12, and 22 is found throughout the specification, including but not limited to the specification at page 5, lines 4-7, and at page 6, line 12 through page 7, line 26.

No new subject matter has been added through new claims 25-26. Support for the new claims 25-26 is found throughout the specification, including but not limited to the specification at page 4, line 21 through page 5, line 7.

Information Disclosure Statement

Applicants submitted an Information Disclosure Statement and a 1449 Form on May 25, 2005. Applicants respectfully request that initialed copies of the 1449 Form be returned to Applicants' Representatives to indicate that the cited documents have been considered by the Examiner.

New claims 25-26

New claims 25-26 depend from independent claim 1, and so include all of the subject matter included in independent claim 1, and more. For at least the reasons stated below with respect to independent claim 1, claims 25-26 are patentable over any proposed combination of documents cited in the Office Action.

Further, a computer search of the documents used in the rejections of the claims in the Office Action was performed, and the terms "User Agent protocol," as included in claim 25, and the term "Composite Capabilities/Performance Profiles protocol," as included in claim 26, were not found in any of the documents including Wise et al., Tseng et al., Aarnio et al., Luzeski et al., Balog et al. and Jimenez et al. Because none of the documents used in the rejections of the claims in the Office Action disclose or suggest at least this subject matter as included in claims

25 and 26, new claims 25 and 26 are not obvious, and are patentable, over any combination of these documents.

Applicants respectfully request consideration and allowance of new claims 25-26.

Claim Objections

Claims 12 and 22 were objected to because of the following informalities:

In claim 12, line 10, the letter "d" appears before the term "color" should be deleted. In claim 22, the last line of the claim, the letter "d" appears before the term "color" should be deleted.

Claims 12 and 22 have been amended to delete the inadvertent inclusion of the letter "d" in each of these claims. Applicants respectfully submit that these amendments overcome the claim objections, and therefore respectfully request withdrawal of the objections to the claims.

§101 Rejection of the Claims

Claims 22-24 were rejected under 35 U.S.C. § 101 on the grounds that the claimed invention is allegedly directed to non-statutory subject matter. Applicants respectfully traverse the rejection of claims 22-24.

Claims 22-24, at least as now amended, are drawn to statutory subject matter, and therefore meet the requirements under 35 U.S.C. § 101 for proper subject matter for a patent. By way of illustration, independent claim 22, as now amended, recites:

"A program product comprising instructions stored on a computer memory, wherein the instructions when read and executed comprise . . ."

According to the MPEP:¹

**35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent*>>< processes, machines, manufactures and compositions of matter. The latter three categories define "things" >or "products"<while the first category defines "actions" (i.e., inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term 'process' means

¹ See Manual of Patent Examining Procedure, Eighth Edition, August 2001, Latest Revision August 2006 at MPEP § 2106 IV. "Determine Whether the Claimed Invention Complies with 35 U.S.C. 101."

process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.").

Thus, the four defined categories of processes, machines, manufactures and compositions of matter are proper subject matter for a patent under 35 U.S.C. 101. Further, according to the MPEP:²

When a computer program is recited in conjunction with a physical structure, such as a computer memory, **USPTO personnel should treat the claim as a product claim.** (Emphasis added).

Independent claim 22 includes, " A program product comprising instructions stored on a computer memory," which Applicant submit falls into at least one of the four defined categories of proper subject matter for patent under 35 U.S.C. § 101. Further, the Office Action has not shown that independent claim 22, either before or after the amendments to independent claim 22 included in this response, falls into one of the recognized areas of subject matter outside the four statutory categories, including an abstract idea, a law of nature, or a natural phenomenon.

For at least the reasons stated above with respect to independent claim 22, and dependent claims 23-24 that depend from independent claim 22, include subject matter that falls into at least one of the four defined categories of proper subject matter for patent under 35 U.S.C. § 101.

Applicants respectfully request reconsideration and withdrawal of the 35 U.S.C. § 101 rejection, and allowance of all claims now pending in the application.

§103 Rejection of the Claims

Claims 1-5 and 8-11

Claims 1-5 and 8-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wise et al. (U.S. Patent 5,884,262) in view of Tseng et al. (6,172,974 B1). Applicants respectfully traverse the rejection of claims 1-5 and 8-11.

Claims 1-5 and 8-11 are not obvious in view of the proposed combination of Wise et al. and Tseng et al.³ for at least the reasons stated below, including that the Office Action has not

² See Manual of Patent Examining Procedure, Eight Edition, August 2001, Latest Revision August 2006 at MPEP § 2106.01 I. "Functional Descriptive Material: 'Data Structures' Representing Descriptive Material *Per Se* or Computer Programs Representing Computer Listings *Per Se*."

meet its burden for establishing a *prima facie* case of obviousness with respect to the rejection of claims 1-5 and 8-11. The proposed combination fails to disclose or suggest all of the subject matter included in claims 1-5 and 8-11.⁴ By way of illustration, independent claim 1 as now amended recites:

A gateway, comprising:

a service sniffer operable to receive from a client device a format informing the gateway about a client device's capabilities including any display capabilities of the client device,

...

a transcoding engine coupled to the one or more of the plurality of portals and operable to convert contents retrieved from the network within multiple fidelities and modalities and to select a proper content version for the client device based on the format informing the gateway about the client device's capabilities; and

a transformation engine to convert a data format used in the contents retrieved from the network into the format supported by the client device based on the format informing the gateway about the client device's capabilities. (Emphasis added).

In contrast to the features from independent claim 1 quoted above, Wise et al. concerns a standard telephone connected to an architecture and then through a computer network to various servers.⁵ In further contrast to independent claim 1, Tseng et al. concerns a wireless communication system having a plurality of mobile switching centers (MSCs), in communication with a plurality of base station controllers (BSCs), each BSC has an associated antenna station for RF wireless communication with a plurality of mobile stations (MSs).⁶

However, neither Wiese et al. nor Tseng et al., when considered alone or when considered together, disclose or suggest, "a service sniffer operable to receive from a client device a format informing the gateway about a client device's capabilities including any display capabilities of the client device," as required by independent claim 1. Further, neither Wiese et al. nor Tseng et al., when considered alone or when considered together, disclose or suggest either of the transcoding engine and the transformation engine, each operable to convert content retrieved from the network

³ Applicants do not admit or agree that any combination of Wise et al. and Tseng et al. is possible.

⁴ To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka* 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

⁵ See e.g. Wise et al. at column 3, lines 51-57.

⁶ See e.g. Tseng et al. at column 4, lines 13-19.

to a format *based on the format provided by the client device informing the gateway about the client device's capabilities*, as required by independent claim 1.

Thus, the proposed combination of Wise et al. and Tseng et al. fails to disclose or suggest at least this subject matter as included in independent claim 1.

Claims 2-5 and claims 8-11 depend from independent claim 1, and so include all of the subject matter included in independent claim 1, and more. For at least the reasons stated above, the proposed combination of Wise et al. and Tseng et al. fails to disclose or suggest all of the subject matter included in claims 2-5 and 8-11, and so claims 2-5 and 8-11 are not obvious in view of the proposed combination of Wise et al. and Tseng et al.

Applicants respectfully request reconsideration and withdrawal of the rejection, and allowance of claims 1-5 and 8-11.

Claims 12-13 and 17-24.

Claims 12-13 and 17-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wise et al. (U.S. Patent 5,884,262) in view of Luzeski et al. (U.S. Patent 6,430,177 B1), in view of Aarnio et al. (U.S. Patent 6,801,793 B1) and further in view of Balog et al. (U.S. Patent Application 2002/0022453 A1). Applicants respectfully traverse the rejection of claims 12-13 and 17-24.

Claims 12-13 and 17-24 are not obvious in view of the proposed combination of Wise et al., Luzeski et al., Aarnio et al., and Balog et al.⁷ for at least the reasons stated below, including that the Office Action has not meet its burden for establishing a *prima facie* case of obviousness with respect to the rejection of claims 12-13 and 17-24.

The proposed combination fails to disclose or suggest all of the subject matter included in claims 12-13 and 17-24. By way of illustration, independent claim 12 as now amended recites:

**receiving from a client device a format including a
description of a client device's capabilities and a user input
including data from the client device;
... and
adapting the contents to a client based on the received
description of the client device's capabilities, including
adapting the contents to a screen size, a screen resolution, and
a [[d]] color depth of the client device based on the format**

⁷ Applicants do not admit or agree that any combination of Wise et al. and Tseng et al. is possible.

from the client device including the description of the client device's capabilities. (Emphasis added).

Applicants believe they have established for at least the reasons stated above with respect to independent claim 1 that Wise et al. fails to disclose or suggest at least this subject matter as required by independent claim 12. Further, Applicants maintain that for at least the reasons set forth in Applicants' previous response,⁸ the discussion in Luzeski et al. concerning accepting a request to read an email or to listen to a voice mail fails to disclose or suggest for instance, "receiving from a client device a format including a description of the client device's capabilities," as required by independent claim 12. Thus, any proposed combination of Wise et al. and Luzeski et al. fails to disclose or suggest all of the subject matter included in independent claim 12.

The addition of either one, or both, of Aarnio et al. and Balog et al. fails to remedy this deficiency in any proposed combinations of Wise et al. and Luzeski et al. Thus, the proposed combination of Wise et al., Luzeski et al., Aarnio et al., and Balog et al. fails to disclose or suggest all of the subject matter included in independent claim 12, and so independent claim 12 is not obvious in view of this proposed combination.

For reasons analogous to those stated above, independent claim 22, at least as now amended, is also not obvious in view of the proposed combination of Wise et al., Luzeski et al., Aarnio et al., and Balog et al. Further, claims 13, 17-21, and 23-24 depend from one of independent claims 12 and 22, and so include all of the subject matter included in the independent claim from which they depend, and more. For at least the reasons stated above with respect to independent claims 12 and 22, claims 13, 17-21, and 23-24 are not obvious in view of the proposed combination of Wise et al., Luzeski et al., Aarnio et al., and Balog et al.

Applicants respectfully request reconsideration and withdrawal of the rejection, and allowance of claims 12-13 and 17-24.

Claims 6-7.

Claims 6-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wise et al. (U.S. Patent 5,884,262) in view of Tseng et al. (6,172,974 B1) and further in view of Jimenez et

⁸ See the Applicants' previous response at pages 11-13 as mailed by Applicants' representatives February 26, 2007 in this application in response to an Office Action mailed October 26, 2006 in this same application.

al. (U.S. Patent Application 2002/0006124 A1). Applicants respectfully traverse the rejection of claims 6-7.

For at least the reasons stated below, the Office Action fails to meet its burden for establishing a *prima facie* case of obviousness with respect to claims 6-7. The proposed combination of Wise et al., Tseng et al., and Jimenez et al.⁹ fails to disclose or suggest all of the subject matter included in claims 6-7. By way of illustration, claims 6-7 depend from independent claim 1, and so include all of the subject matter included in independent claim 1, and more. Applicants believe they have established that the proposed combination of Wise et al. and Tseng et al. fails to disclose or suggest all of the subject matter included in independent claim 1.

Applicants fail to find in, and the Office Action fails to point out where in Jimenez et al. there is a disclosure or suggestion of the subject matter included in claims 6-7 and missing from Wise et al. and Tseng et al. Thus, the proposed combination of Wise et al., Tseng et al., and Jimenez et al. fails to disclose or suggest all of the subject matter included in claims 6-7.

Applicants respectfully request reconsideration and withdrawal of the rejection, and allowance of claims 6-7.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Office Action. Applicants' silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance

⁹ Applicants do not agree or admit that any combinations of Wise et al., Tseng et al., and Jimenez et al. are possible.

on Official Notice, and reserve all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney (612-371-2132) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date OCTOBER 4, 2007

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4th day of October 2007.

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